

IN THE CLAIMS:

Please amend the claims as follows.

A¹
4. (Amended) The mining apparatus of claim 3 wherein said pan passes beneath said auger mining machine so that mined material provided by the auger mining machine falls to said pan.

Please add the following new claim.

A²
12. (New) The mining apparatus of claim 1, wherein said conveyer includes at said position spaced from said forward end means to receive the mined material delivered by the auger mining machine.

A clean copy of the amended claims is attached hereto as Attachment A.

REMARKS

Claims 1-5 are under consideration in the present application, claims 6-10 having been withdrawn from consideration for being directed to a non-elected invention. The Examiner has objected to claim 4 due to an informality, and has rejected claims 1-5 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,395,940 (Young, *et al.*) in view of U.S. Patent No. 5,634,545 (Plumley).

Applicants have amended claim 4 to correct the claim dependency as noted by the Examiner.

Applicants respectfully traverse the section 103 rejection of claims 1-5.

Applicants urge that the Examiner has failed to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify or combine the reference teachings. Second, there must be a reasonable expectation of success.

Finally, the combination of the prior art references must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not be based on the Applicants' disclosure.

Applicants claim 1 is directed to a mining apparatus that, *inter alia*, includes an auger mining machine that delivers the mined material to an intermediate position of the conveyor, i.e. to a position that is spaced from the forward end of the conveyor, so that the forward end of the conveyor can receive material mined in forming the road along which the conveyor extends. Neither of the references cited by the Examiner discloses or suggests a mining machine so constructed.

Young is directed to a mining machine that includes a transverse auger apparatus that delivers mine material to a conveyer that extends rearwardly therefrom. In particular, the transverse auger is positioned such that the conveyor cannot extend forwardly beyond its designed position with respect to the auger. The Examiner concedes that Young fails to disclose a conveyor adapted to receive mining material at the forward end, but then takes the position that Plumley discloses a conveyor that includes a hopper adapted to receive material at the forward end. However, Plumley does not disclose the claimed relationship between an auger mining machine and a conveyor wherein the auger mining machine delivers material to an intermediate position of the conveyor which is spaced from the forward end. Accordingly, and since the only reference that teaches an auger mining machine/conveyer relationship (Young) teaches that the conveyor extends only rearwardly of the auger apparatus, combining the conveyor of Plumley with Young's mining machine would result in a mining machine with a conveyor extending in one direction only from the transverse auger, namely rearward. There is no teaching in either Young or Plumley to have a conveyor that can also extend forwardly from the transverse auger. Further, there is no motivation in either Young and Plumley to modify Young's mining machine to extend forwardly of the auger machine, since there is no disclosure in either reference of a machine to form the mine road.

Thus, as explained above, neither Young nor Plumley teach or suggest a conveyor that can extend both forwardly and rearwardly of the transverse auger, as claimed in Applicants' claim 1. Finally, the combination of Young and Plumley fails to include all of the limitations of Applicants' claim 1, specifically an auger mining machine spaced away from the forward end of the conveyor. Since the combination of Young and Plumley does not satisfy the criteria for a *prima facie* case of obviousness, Applicants' claim 1 is not obvious over these references. Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 2-5 all ultimately depend from claim 1, and are thus patentable for the same reasons as claim 1. Reconsideration and withdrawal of these rejections are respectfully requested.

CONCLUSION

Applicants urge that claims 1-5, as amended, and new claim 11, are in condition for allowance. Early and favorable action is earnestly solicited. If the Examiner believes that issues can be resolved through a telephone interview, the Examiner is urged to call the undersigned at the telephone number listed below.

Respectfully submitted,

CLIFFORD J. MASS
LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890

Attachment A
Claims showing changes

4. (Amended) The mining apparatus of claim 3 [2] wherein said pan passes beneath said auger mining machine so that mined material provided by the auger mining machine falls to said pan.